

## **REMARKS**

### **I. General**

Applicant gratefully acknowledges the indication of allowability of claims 14-21. Applicant hereby traverses the outstanding rejections of the remaining claims and requests reconsideration and withdrawal in view of the remarks contained herein. Claims 1-8, 10-14, 22-23 and 25-30 are rejected. Claims 9 and 24 are objected to as being dependent from a rejected base claim. Claims 1-30 are pending in this application.

### **II. Rejection under 35 U.S.C. § 103 (Smith)**

Claims 1-8, 10-13, 22-23 and 25-30 are rejected under 35 U.S.C. § 103(a) as being unpatentable over United States Patent Number 5,455,409 to Smith et al. (hereinafter "Smith"). To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. See M.P.E.P. § 2143. Without admitting that the second or third criteria are satisfied, the Applicant respectfully asserts that the Examiner's rejection fails to satisfy the first criteria.

Claim 1 recites, in part, "commanding at least one selected data transfer element in said library to only accept media having particular ones of said identification numbers." As the Examiner admits, Smith does not describe at least this limitation.

Smith describes a cabinet and carrier for storing and retrieving articles, such as magnetic tape drives. Abstract. Each article has an associated identifier, the "VOLSER" number, which is used by the retrieval mechanism to identify the contents of the storage locations in the cabinet. Id. A host computer controls the operation of the system, but no central database is maintained of the coded articles, instead the identifiers are stored in respective memories associated with each article. Id.

The mechanism of Smith is described further with reference to Figures 14A and 14B. When a tape request command is received by the system, the VOLSER number is read into



the RAM of the microcontroller. Column 24, lines 39-41. The VOLSER number stored in RAM is then compared against the VOLSER numbers of the tape cartridges by sequentially reading the VOLSER numbers from the respective EEPROM memories thereof. Col. 24, lines 44-50.

In attempting to show that the claim is obvious over the art of record, the Examiner asserts that “by determining the location of the requested medium (tape) with respect to matching VOLSER numbers, it’s clearly understood that any transfer element within Smith’s system must only accept media associated with the matching VOLSER number to avoid transferring any unmatched media or unmatched media data to the host.” Office Action at page 4. However, it is a fundamental concept of Smith that, by identifying the tape by the VOLSER number stored in the EEPROM memory affixed to the tape cartridge, only the media associated with the matching VOLSER number will be selected for use with the transfer element. *See e.g.*, col. 26, lines 54-59. Accordingly, tape cartridges that do not have a matching VOLSER number are never sent to the transfer device and cannot therefore be rejected. Column 24, lines 57-61. One of ordinary skill in the art would not have been led to modify the system of Smith to command a data transfer element to only accept media having particular ones of the VOLSER numbers because Smith teaches that only the tape having the proper VOLSER number will be selected for use with the data transfer element.

In proffering a statement of motivation with respect to the foregoing modification to Smith, the Examiner asserts that “it would have been obvious to one having ordinary skill in the art at the time the current invention was made to implement the data transfer element in the library to only accept media having matching VOLSER number or matching identification number as being claimed [because] it would enhance system reliability; reducing data transferring error by avoiding reading wrong data in any unmatched media, therefore being advantageous.” Office Action at pages 4 and 5. The Examiner has not provided an objective reason to combine the teachings of the references. *See* M.P.E.P. 2142.01. The reason provided by the Examiner—i.e., “to enhance system reliability,” is a general incentive, and not an objective reason. Applicant points out that “[a] general incentive does not make obvious a particular result, nor does the existence of techniques by which those efforts can be carried out.” *In re Deuel*, 51 F.3d 1552, 1559 (Fed. Cir. 1995). Therefore, the motivation provided by the Examiner for modifying Smith is improper.



Moreover, the fact that references can be combined or modified is not sufficient to establish a *prima facie* case of obviousness. M.P.E.P. § 2143.01. The language of the recited motivation is circular in nature, stating that it is obvious to make the modification (command a data transfer element to only accept media having particular identification numbers) because it is obvious to achieve the result (avoid reading wrong data from media not having particular identification numbers). Such language is merely a statement that the reference can be modified, and does not state any desirability for making the modification. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. M.P.E.P. § 2143.01 (citing *In re Mills*, 916 F.2d 680, (Fed. Cir. 1990)). Thus, the motivation provided by the Examiner is improper, as the motivation must establish the desirability for making the modification.

Additionally, Applicant respectfully submits that the Examiner's proposed modification of Smith would require substantial unsuggested modification to meet the claim. The only information that Smith operates on is a VOLSER number in a tape request command. Having only this information in the microcontroller, the system as shown and described in Smith cannot do anything other than determine if the requested tape exists, find its location and deliver it to the transfer device. Smith has no means to determine the propriety of the VOLSER number associated with a tape cartridge provided to a transfer element. Without any other structure, which Smith explicitly states does not exist (see, Abstract), Smith cannot be modified to command a data transfer element, to only accept media associated with a set of identification numbers as the Examiner's attempted modification requires. As the Examiner's proposed modification is improper given the explicit teachings of Smith, Applicant respectfully asserts that claim 1 is allowable over the rejection of record.

Claim 22 recites, in part, "a plurality of data transfer elements that are adapted to receive said media and transfer data to and from said media, . . . wherein access to said media by each of said data transfer elements is restricted to media having particular ones of said identification numbers." Again, the Examiner admits that Smith does not disclose that access to the media by each of the data transfer elements is restricted to media having particular ones of the identification numbers. Office Action at page 8. As with claim 1, the Examiner



attempts to show that the claim is obvious over the art of record, by asserting that “by determining the location of the requested medium (tape) with respect to matching VOLSER numbers, it’s clearly understood that any transfer element within Smith’s system must only accept media associated with the matching VOLSER number to avoid transferring any unmatched media or unmatched media data to the host.” Office Action at pages 8-9.

As described above, however, it is a fundamental concept of Smith that only the media associated with the matching VOLSER number will be selected for use with the transfer element, and therefore, tape cartridges that do not have a matching VOLSER number are never sent to the transfer device and cannot therefore access to the data transfer elements would never need to be restricted. *See e.g.*, col. 26, lines 54-59 and column 24, lines 57-61. One of ordinary skill in the art would not have been led to modify the system of Smith to restrict access to said media by each of said data transfer elements to media having particular ones of said identification numbers because Smith teaches that tapes are only retrieved in response to tape request command and only the tape having the VOLSER number contained in the tape request command will be selected for use with the data transfer element. Smith never discloses any type of vetting of tape request commands, only the reading of the associated VOLSER number and searching the EEPROM devices for a match.

Again, the Examiner’s stated motivation with respect to the foregoing modification to Smith is that “it would have been obvious to one having ordinary skill in the art at the time the current invention was made to implement the data transfer element in the library to only accept media having matching VOLSER number or matching identification number as being claimed [because] it would enhance system reliability; reducing data transferring error by avoiding reading wrong data in any unmatched media, therefore being advantageous.” Office Action at page 9. This is not an objective reason to combine the teachings of the references as required under M.P.E.P. 2142.01 but rather a general incentive. *See, In re Deuel*. Therefore, the motivation provided by the Examiner for modifying Smith is improper.

As with claim 1, the Examiner’s proposed modification of Smith would require substantial unsuggested modification to meet the claim. Without any other structure, which Smith explicitly states does not exist (see, Abstract), Smith cannot be modified to restrict



access to said media by each of said data transfer elements to media having particular ones of said identification numbers as the Examiner's attempted modification requires. As the Examiner's proposed modification is improper given the explicit teachings of Smith, Applicant respectfully asserts that claim 22 is allowable over the rejection of record.

Claims 2-8 and 10-13 depend directly from claim 1 and therefore inherit all the limitations thereof. Claims 2-8 and 10-14 are, therefore, allowable for at least the reasons set forth with respect to claim 1. Claims 23 and 25-30 depend directly from claim 22 and therefore inherit all the limitations thereof. Claims 23 and 25-30 are, therefore, allowable for at least the reasons set forth with respect to claim 22.

### **Conclusion**

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Applicant believes no fee is due with this response. However, if a fee is due, please charge Deposit Account No. 08-2025, under Order No. 30014514-1 from which the undersigned is authorized to draw.

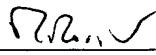
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Respectfully submitted,

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